

FORM PTO -1083  
Mail Stop: AMENDMENT  
COMMISSIONER FOR PATENTS  
Alexandria, VA 22313-1450



1625  
TW  
Docket No.: 800.1019  
Date: January 28, 2008

In re application of: Sarina STRIEM  
Serial No.: 10/529,028  
Filed: March 24, 2005  
For: LIPOPHILIC DIESTERS OF CHELATING AGENT FOR INHIBITION OF ENZYME ACTIVITY

Sir:

Transmitted herewith is a **Response To Restriction Requirement ( 4 pages)** in the above-identified application.

- ☐ Small entity status under 37 C.F.R. 1.9 and 1.27 has been previously established.
- ☐ Applicants assert small entity status under 37 C.F.R. 1.9 and 1.27.
- ☒ No fee for additional claims is required.

☒ Also transmitted herewith are:

- ☐ Petition for extension under 37 C.F.R. 1.136 (in duplicate)
- ☒ Other: return receipt postcard

☐ Check(s) in the amount of **\$0.00** is/are attached to cover:

- ☐ Basic filing fee in the amount of \$0.00
- ☐ Petition fee for extension under 37 C.F.R. 1.136
- ☐ Other:

☒ The Assistant Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-0552.

- ☒ Any filing fee under 37 C.F.R. 1.16 for the presentation of additional claims which are not paid by check submitted herewith.
- ☒ Any patent application processing fees under 37 C.F.R. 1.17.
- ☒ Any petition fees for extension under 37 C.F.R. 1.136 which are not paid by check submitted herewith, and it is hereby requested that this be a petition for an automatic extension of time under 37 CFR 1.136.

Julie Bowker, Reg. No. 37,870  
DAVIDSON, DAVIDSON & KAPPEL, LLC  
485 Seventh Avenue, 14<sup>th</sup> Floor  
New York, New York 10018  
Tel: (212) 736-1940  
Fax: (212) 736-2427

I hereby certify that this correspondence and/or documents referred to as attached therein and/or fee are being deposited with the United States Postal Service with sufficient postage as "first class mail" in an envelope addressed to Mail Stop: Amendment, Commissioner for Patents, Alexandria, VA 22313-1450 on January 28, 2008.

DAVIDSON, DAVIDSON & KAPPEL, LLC

BY:   
Luis Baez



800.1019

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re.: Application of: Sarina Striem, et al.  
Serial No.: 10/529,028  
Filed: March 24, 2005  
For: **LIPOPHILIC DIESTERS OF  
CHELATING AGENT FOR  
INHIBITION OF ENZYME ACTIVITY**  
Examiner: OH, TAYLOR V. (Art Unit 1625)

Mail Stop: AMENDMENT  
Commissioner of Patents  
P.O.Box 1450  
Alexandria, VA 22313-1450

January 28, 2008

**RESPONSE TO THE DECEMBER 26, 2007 RESTRICTION REQUIREMENT**

Sir:

This communication is being submitted in response to the Restriction Requirement dated December 26, 2007. The due date for responding to the Restriction Requirement was January 26, 2008, which fell on a Saturday. Accordingly, a response is due the next business day, January 28, 2008, and this communication is being timely filed. Applicants believe no fee is associated with the filing of this response, but if it is determined that any fee is due, the Commissioner is authorized to charge such fee to our Deposit Account No. 50-0552.

Claims 1, 2, 5-9, 11-15, 17-23, 26-28, 30 and 31 are pending in the case. In the December 26, 2007 Restriction Requirement, the Examiner maintained that the claims of the subject application are directed to five groups of inventions, which are not linked by a

single inventive concept, and required that the Applicants elect one of those groups for further prosecution. The five groups are as follows:

- I. Claims 1-2 and 5-8, drawn to a method of inhibiting protease activity using a compound of formula (I);
- II. Claims 9 and 11-15, drawn to a method for preventing or treating a MMP-related disease using a compound of formula (I);
- III. Claims 17-18, drawn to a method for preventing or treating a cancer using a compound of formula (I);
- IV. Claims 19-23 and 26, drawn to a method for treating angiogenesis dependent disease using a compound of formula (I); and
- V. Claims 27-28 and 30-31, drawn to a method for preparation of a medicament using a compound of formula (I), and its pharmaceutical compositions and compounds.

The Examiner maintained that the inventions of Groups I-V do not relate to a single inventive concept under PCT Rule 13.1, because they do not meet the requirements of PCT Rule 13.2 that there be "a technical relationship among those inventions involving one or more of the same or corresponding technical features."

In response, Applicant elect with traverse Group II (claims 9 and 11-15) for further prosecution. Claims 9 and 11-15 are directed to a method for preventing or treating a MMP-related disease or disorder using a compound of formula (I).

Applicants traverse the Examiner's Restriction Requirement. As the basis for dividing the claims into five separate groups, the Examiner relied on PCT Rule 13.2, which states as follows:

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features

that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

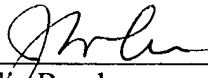
Applicants respectfully submit that at least for claims in Groups I-IV, they share a technical relationship that involves "one or more of the same or corresponding special technical features," as to satisfy the requirements of PCT Rule 13.2. Specifically, claims in Groups I-IV share a common inventive concept, namely, that compounds of the general formula (I) can inhibit the activity of matrix metalloproteinases (MMPs) in a selective manner. Because of that inhibitory activity, the compounds are useful in methods for preventing, treating or managing diseases or disorders where an elevated activity of MMP plays a role. For example, it has been established that diseases such as cancer (including metastasis cancer) and angiogenesis-dependent diseases (e.g., arthritis, macular degeneration, diabetic retinopathy, rheumatic and autoimmune diseases), as well as diseases or disorders related to inflammatory conditions (e.g., arthritis, atherosclerosis), are all associated with increased activity of MMPs.

In restricting out the claims, the Examiner cited U.S. Patent No. 5,776,933 (the '933 patent) for support. Applicants respectfully submit that the '933 patent does not establish that the claims of the present application are directed to separate inventions. In fact, the '933 patent does not appear to be relevant to the claimed subject matter of the present application. That patent relates to compounds which are entirely different from compounds of the present invention (namely, compounds of formula (I)). In addition, the '933 patent appears to be relate to inhibition of retroviral proteases, particularly HIV protease, and not to the inhibition of matrix metalloproteinases (MMPs).

In addition, Applicants respectfully note that, although the Examiner has asserted that the claims are not so linked as to form a single inventive concept under PCT Rule 13.1, the International Searching Authority did not previously find the claims to be lacking in unity.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the restriction requirements.

Respectfully submitted,  
DAVIDSON, DAVIDSON & KAPPEL, LLC

By:   
Julie Bowker  
Reg. No. 37,870

Davidson, Davidson & Kappel, LLC  
485 Seventh Avenue, 14<sup>th</sup> floor  
New York, NY 10018  
(212) 736-1940